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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91204599
Party	Defendant Shamim Akhter, partnership DBA Shamim Akhter
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Attachments	Opposition to Petition to Disqualify.pdf (8 pages)(21288 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIALS AND APPEALS BOARD**

GILDA A. SOLIS and STILLMAN DE	§	
MEXICO S.A. DE C.V.	§	
Opposers,	§	Opposition No. 91/204,599
	§	
v.	§	Serial No. 85/092,438
	§	
SHAMIM AKHTER, partnership DBA	§	
Shamim Akhter	§	Mark: STILLMAN'S
	§	
Applicant.	§	

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trials and Appeals Board
P.O. Box 1451
Alexandria, VA 22313-1451

APPLICANT’S OPPOSITION TO OPPOSER’S PETITION TO DISQUALIFY

Gilda A. Solis and Stillman de Mexico S.A. de C.V. (“Opposers”) filed a Petition to disqualify counsel for Shamim Akhter, partnership DBA Shamim Akhter (“Applicant”), apparently only on a basis that Opposer wish to call counsel for Applicant as a witness and there is some kind of conflict. Applicant opposes the granting of the Petition on the basis that Opposers are wrong on the issues in this case, wrong on the facts, and are wrong on the law.

I. Opposers are wrong on the issues.

In the Amended Petition of Opposition, Opposers from Mexico allege that it has been using the trade name” Stillman’s” in Mexico, and is the predecessor in interest of a former owner and user of the mark, a Delaware corporation. The now dissolved former owner (The

Stillman Company, a corporation of Delaware dissolved in about 2009) was the owner and user of the now abandoned mark STILLMAN'S and owner of the now cancelled registration for Stillman's (Reg. No. 0,172,550, cancelled in 2004 for failure to file a renewal Section 8).

Opposers also claim to have rights to the mark through use of the mark in the United States, but that use seems to be during the time the former owner had a registration and was using the mark in the United States. It is difficult to understand how Opposers could build up any rights in the mark if such use was in violation of another's registration.

On July 26, 2010, Applicant filed a Section 44(e) application (now involved in this Opposition proceeding) based on a Pakistan registration. Applicant has not alleged any use of its mark in the United States in its application.

Thus the issues in this Opposition Proceeding are clear. Who has priority? Which party, Opposers or Applicant, is the rightful owner of the mark? That is, which is the first U.S. user of the mark or has prior rights to the mark? Applicant has not claimed any current use of the mark in the United States and has not claimed any predecessors in interest. Therefore Applicant is left to its filing date of the application being opposed. If Opposer is the prior user or has prior rights to use the mark, that is for Opposer to prove. Neither Applicant nor its counsel have any role to play in that proof and a deposition of counsel for Applicant will not assist in that proof. There are no facts that either Applicant or its counsel can prove that are not of record, namely the application filing date. Therefore, with respect to the issue in this case, a deposition of the counsel for Applicant cannot elicit any relevant or material facts.

II. Opposers are wrong on the facts.

Opposers in their petition make it sound like the present counsel for Applicant is an officer or employee of Applicant. The Applicant is a Pakistan partnership. Counsel for Applicant is neither an officer or employee of Applicant and Opposers have not explicitly alleged such. The exact composition of Applicant and the roll of its counsel in that company can easily be found by discovery that does not involve the taking of the deposition of counsel for Applicant. However, it can be determined by taking the deposition of a partner of Applicant. In this regard, Applicant has generously agreed, and advised in writing to counsel for Opposers, to present a partner of Applicant for a deposition in the United States if someone from each Opposer will similarly agree. Also, counsel for Opposers could determine in a sworn statement the status of counsel for Applicant by asking Interrogatories. Again there is no need for a deposition of counsel to determine all of the relevant facts.

Opposers in paragraph 1 of the Petition make it sound like The Stillman Company, Inc., a corporation of Virginia (“Stillman VA”), is involved in this Opposition. It is not. Opposers in paragraph 1 of the Petition make it sound like the two registrations cited in the Petition are involved in this Opposition. They are not.

Opposers in paragraph 2 of the Petition make it sound like that Brian E. Banner and Jared D. Barsky are members of the firm H & A Intellectual Property Law, PLLC, the firm that Opposers are trying also to disqualify. They are not. Brian E. Banner resigned from the firm on May 31, 2012 and started his own firm, based currently in the District of Columbia. He had

nothing to do with either Applicant's Application or this Opposition proceeding, and no relevant facts were alleged in the Petition. Jared D. Barsky left the firm on April 9, 2012, and he became a patent examiner with the U.S. Patent and Trademark Office. He had nothing to do with either Applicant's Application or this Opposition Proceeding and no relevant facts were alleged in the Petition.

Opposers in Paragraph 8 of the Petition make it sound like counsel for Applicant is involved in this case simply on the basis that he is President and Secretary of a company that is not involved in this Opposition. They then state that on that basis he will be a witness to testify on behalf of Applicant. That is not true. As stated above, the issue in this case does not involve Applicant's use of the mark or anything other than its filing date. Counsel for Applicant is not needed to determine that issue and there is nothing alleged in the Petition that would provide any relevancy for any information or facts that he could give.

Opposers in Paragraph 6 allege "on information and belief," but without any statement of facts, that there is a conflict of interest by counsel for Applicant. All it says is that counsel for Applicant is also an officer of another company not involved in this Opposition Proceeding. Yet there is no such conflict of interest because as stated in Paragraph 4 of the Petition, the partners of Applicant are also the directors of that other company. Simply because of this connection, there cannot be any conflict of interest because the attorney for Applicant is working for the same persons.

The Petition to Disqualify sets forth no facts and no specific allegations why the law firm of the counsel for Applicant should be disqualified. All it says in Paragraph 7 is that “a conflict of interest of interest exists between the H & A Law Firm, Applicant and The Stillman Company.” Without alleging how such a conflict arises (and assuming that is the standard, which it is not), Opposers have not met their burden of proof. Opposers cite 37 CFR § 10.66 for this alleged conflict. However, that section is inapposite because it deals with a withdrawal of counsel because of a Disciplinary Rule violation. 37 CFR §10.66(d). There have been no facts or allegations stated by Opposers that counsel for Applicant has been involve in any unethical activity or violation of a disciplinary rule. See TBMP §513.02 where it explicitly states that “petitions to disqualify are not disciplinary proceedings.” Consequently, because there is no violation of a disciplinary rule alleged, there is no reason why the law firm of counsel for Applicant must be disqualified. Further, none of the attorneys mentioned in the Petition are currently members or employees of the law firm.

In summary, there are no relevant facts alleged in either the Amended Notice of Opposition or the Petition to Disqualify that involve either a conflict of interest, would require counsel for Applicant to testify, or allege a violation of the disciplinary rules..

III. Opposers are wrong on the law.

Opposers indicate in their Petition that counsel for Applicant should be disqualified because there is a conflict of interest. But such a conflict should be between adverse or

opposing parties. Counsel for the Applicant has no present or past connection with the Opposers and none has been alleged.

Nevertheless there is no conflict according to the rules. According to 37 CFR § 10.66 (c), a “practitioner may represent multiple clients if it is obvious that the practitioner can adequately represent the interest of each...” The allegations in the Petition and the Amended Notice of Opposition state that counsel for Applicant is representing different parties, Applicant in this proceeding and as practitioner in the two applications mentioned in paragraph 1 of the Petition. However counsel for Applicant is representing the same persons. These persons are both the members of the partnership that is the Applicant, and the directors of the other company that is not involved in this Opposition Proceeding.

As stated in the cases, the mere allegation that Opposers intend to call counsel for Applicant as a witness, without more, is insufficient to disqualify him and his firm. See Davis v. Stamier, 494 FS 339 (D. NJ, 1980). And, in that case, the prejudicial effect of opposing counsel’s testimony must be prejudicial to opposing counsel’s client. That is certainly not the case, and in any event, no such relevant facts were alleged. See, Kroungold v. Triester, 521 F.2d 763 (3rd Cir. 1975) (Defendant’s intent to call law partner of attorney for Plaintiff as an adverse witness, coupled with the mere suggestion that the testimony “may prejudice” the plaintiff was insufficient to support a disqualification petition).

The principal consideration under the PTO rule 10.63 is whether an attorney ought to be called to testify on behalf of his client or the testimony would be prejudicial to the clients. The operative word here is “ought” to be called. There is no reason to call an attorney if the only evidence that attorney has is irrelevant and immaterial to the issues in the case. There is no prejudice to any client if the same persons are involved in each client.

As the law presently stands, and as the facts that exist in this case, and in view of no specific facts alleged to the contrary, Opposers simply have not met their burden for their Petition to be granted.

IV. Conclusion.

In view of the above facts and arguments, Opposers have not met their burden to show that there is any conflict of interest or that they “ought” to call counsel for Applicants as a witness. Accordingly, the Petition must be denied.

Respectfully Submitted,

H & A INTELLECTUAL PROPERTY LAW, PLLC

Dated: September 25, 2012

By: _____
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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing APPLICANT'S OPPOSITION TO OPPOSER'S PETITION TO DISQUALIFY was served on the Attorney for Opposer on this September 25, 2012 by first-class mail, postage pre-paid to the following address:

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